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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/256,540

Applicant(s)  
Baser et al.

Examiner  
Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 12, 2001 and Feb 27, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-31, and 33-38 is/are pending in the application.
- 4a) Of the above, claim(s) 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17, and 33-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on February 12, 2001, and the Election filed on February 27, 2002 which paper has been placed of record in the file.
2. Claims 1-7, 10-17, and 33-38 are elected for consideration.

#### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-7, 10-17 and 33-38 have been fully considered but are moot in view of the new grounds of rejection.
4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7, 10-17, and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "the transaction server" recited in claim 1, lines 6, 8, 9, 16, is lack of antecedent basis.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 6, 7, 10-13, 15-17, 33, and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Lesley, U.S. Patent No. 6,188,752.

Regarding to claim 1, Lesley discloses a method of performing a pre-paid electronic-commerce transaction over a computer network, comprising the steps of:

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receiving user identification and account balance information at a centralized transaction server interface to the network (column 8, lines 1-25);

receiving a request for goods or services at the transaction server from the user through an input device (column 4, lines 23-57);

creating a transaction instance at the transaction server in response to the user request (column 7, lines 34-60);

retrieving account information at the transaction server relating to the user, the account information including the user's remaining balance (column 8, lines 25-30);

determining whether or not the transaction can take place as a function of the user's remaining balance (column 8, lines 25-30);

proceeding with the transaction and servicing the request if the user's account is sufficiently funded (column 8, lines 30-35);

calculating the purchase price of the requested goods or service (column 8, lines 35-46);  
and

updating user's remaining balance at the transaction server (column 8, lines 47-50).

Regarding to claim 2, Lesley further discloses the transaction occurs over the Internet (figure 1, item 11).

Regarding to claim 6, Lesley further discloses the step of: denying further service requests when a predetermined spending threshold is reached (column 8, lines 25-31).

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Regarding to claim 7, Lesley further discloses further discloses the input is received through a web page (column 6, lines 43-55).

Regarding to claim 10, Lesley further discloses the step of calculating the purchase price of the requested goods or services occurs in real time (column 8, lines 35-46).

Regarding to claim 11, Lesley further discloses further discloses the purchase price is a dollar or less (column 1, lines 45-46).

Regarding to claims 12, 13, Lesley further discloses the steps associated with receiving the request from the user and servicing the request are performed at different location; and one or more of the other steps are performed at one or more different locations, one of the different locations is associated with requesting a payment, and wherein that location passes accounting and rating information to the first location (figure 1 and column 4, line 24-column 6, line 55).

Regarding to claim 15, Lesley further discloses the step of providing the user with a history of payments over the network (column 7, lines 34-60).

Regarding to claim 16, Lesley further discloses further discloses the step of allowing the user to move funds from a bank or credit card account to increase the remaining balance (column 9, line 5-column 10, line 23).

Regarding to claim 17, Lesley further discloses the input device forms part of a personal digital assistant (figure 1, item 14c and column 4, lines 35-36).

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Regarding claim 33, Lesley further discloses the step of calculating the cost of the requested goods or services is based upon the amount of time spent in using the goods or services (column 8, lines 35-46).

Regarding claim 36, Lesley discloses a method of performing a pre-paid electronic-commerce transaction for a user having an account, comprising the steps of:

receiving a request from a user over a computer network, thereby creating a transaction instance (column 8, lines 1-25 and column 7, lines 34-60);

calculating the cost of the transaction as a function of transaction time (column 8, lines 35-46); and

debiting the user's account in accordance with the cost upon termination of the transaction (column 8, lines 47-50).

Regarding claim 37, Lesley further discloses the steps of:

retrieving account information at least including the user's remaining balance (column 9, lines 45-50);

determining whether or not the transaction can take place as a function of the user's remaining balance (column 8, lines 25-30);

proceeding with the transaction if the user's account is sufficiently funded (column 8, lines 30-35); and

updating the user's remaining balance upon termination of the transaction (column 8, lines 47-50).

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Regarding claim 38, Lesley further discloses the computer network is the Internet, an Intranet, or Extranet (column 4, lines 24-48).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5, 14, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lesley, U.S. Patent No. 6,188,752.

Regarding to claims 3, 4, Lesley does not disclose the transaction occurs over an Intranet or Extranet. However, it well known in the art to perform a transaction over an Intranet or Extranet. Intranet or Extranet are typical private networks owned or controlled by the company or corporate user. Intranet or Extranet are compatible with the Internet protocol and often the same software used on connection with the Internet (e.g., Web browser). Intranet or Extranet are established to connect to the Internet through a firewall (i.e., a hardware/software combination designed to restrict unauthorized access to the Intranet). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to include Intranet or Extranet as discussed above for the security purposes.



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Regarding to claim 5, Lesley does not disclose the request receive through a point-of-sale (POS) terminal. However, it is well known that a user purchases product a point-of-sale (POS) terminal such as at a store. A point-of-sale terminal usually contains a card reader so the user can paying for products purchased by swiping a credit card or debit card. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to apply the prepaid service at a point-of-sale terminal so the user does not require to carry any credit card or debit card that can be lost, stolen or damaged.

Regarding to claim 14, Lesley does not disclose providing the user with an estimated purchase price over the network before a purchase is made. However, it is well know to provide the user with an estimated purchase price before a purchase is made. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to include the feature above for the purpose of confirming the purchase price with the user, so the user can decides to accept or cancel the transaction.

Regarding claims 34, 35, Lesley does not disclose the goods or service involve downloading reading material, a form of entertainment. However, it is well know that a user can access the Internet to download files, music, or movies and pay for the downloading service. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Lesley's to apply the prepaid service for the user to pay for the downloading reading material or a form of entertainment over the Internet.

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***Conclusion***

11. Claims **1-7, 10-17** and **33-38** are rejected.

12. The prior arts made of record are considered pertinent to applicant's disclosure:

Pare, Jr. et al. (US 6,192,142) discloses a method and device for tokenless authorization of a stored value transaction between a payor and a payee.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh, can be reached on (703)308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

14. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

**or faxed to:**

(703) 305-7687, (for formal communications intended for entry)

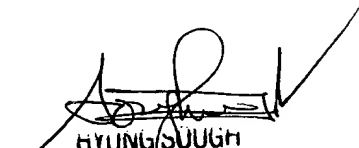
**or:**

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(703) 308-3961 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen  
April 2, 2003

  
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